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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/285,306	04/02/1999	THOMAS GINGERAS	018547-01857	3558
33522	7590	10/04/2004	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20004			WILDER, CYNTHIA B	
			ART UNIT	PAPER NUMBER
			1637	
DATE MAILED: 10/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/285,306

Applicant(s)

GINGERAS ET AL.

Examiner

Cynthia B. Wilder, Ph.D.

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 0200.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4,6,8,11-16,18 and 19 is/are allowed.
- 6) ☒ Claim(s) 17 is/are rejected.
- 7) ☐ Claim(s) 5,7,9,10 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1637

DETAILED ACTION

1. Finality of the Office action submitted on May 24, 2004 is withdrawn in view of new grounds of rejections. The amendment filed on August 11, 2004 is acknowledged and has been entered. Claim 1 has been amended. Claims 1-19 are pending in the instant application and addressed below.

Specification and Drawings

2. The disclosure is objected to because of the following informalities:

The specification and drawings are objected to because the specification makes reference to Table 1. However, there is no Table 1 anywhere in the specification. The specification recites a figure 1 submitted on April 2, 1999 and another figure 1 submitted on April 4, 2002. None of the figures contain SEQ ID NOS as indicated in the specification.

Clarification and appropriate correction is required.

Claim Objections

3. Claims 5, 7, 9, 10 is objected to because of the following informalities:

(a) Claim 5 is objected to because the scope of the claim does not further limit claim 4 from which it depends. The claim 5 is broader in scope than claim 4 from which it depends..

(b) Claim 7 is objected to because the sequence identifier "SEQ ID NOS." and "SEQ ID NO." is improper. It is suggested changing "SEQ ID NOS." and "SEQ ID NO." to --SEQ ID NOS:-- and --SEQ ID NO:--.

(c) Claim 9 and 10 are objected to because the scope of the claims do not further limit claim 8 from which they depend. The claims 9 and 10 are broader in scope than claim 8 from which they depend.

Art Unit: 1637

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) The claim 17 is indefinite at the recitation of "stringent conditions" because the definition in the specification is ambiguous and it cannot be determine what hybridization conditions are required for the polynucleotide probe. It is suggested amending the claims to recite the stringent hybridization conditions.

Conclusion

6. Claims 5, 7, 9 and 10 have been objected. Claim 17 is rejected. The claims have not been rejected under prior art and contain allowable subject matter as indicated in the previous office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is (571) 272-0791. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be emailed to cynthia.wilder@uspto.gov.

